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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,952	08/03/2001	Hiroshi Satomi	B422-167	8387

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EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,952

Applicant(s)

SATOMI ET AL.

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/22/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>Mar. 22, 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Information Disclosure Statement

2. The information disclosure statement submitted on March 22, 2004 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claims 7 and 35, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 55, 57 and 59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claims 55, 57 and 59, claim the non-statutory subject matter of a program to be executed on a computer. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Therefore, since the claimed programs are not tangibly embodied in a physical medium and encoded on a computer-readable medium then the Applicants has not complied with 35 U.S.C 101.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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9. Claims 1-4,6-20,22-26,28-32,34-52,54-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Mousseau et al. US Patent 2001/0005864.

Regarding claim 1, Mousseau teaches an information providing system (abstract; fig. 1) comprising:

receiving means for receiving electronic mail information, (paragraph 0049);

first determining means (redirector program) for determining whether or not said electronic mail information can be outputted in a destination of said electronic mail information, (paragraphs 0016,0034,0035 and 0042);

issuing means for issuing code information for outputting said electronic mail information in another terminal if it is determined by said first determining means that said electronic mail information cannot be outputted, (paragraphs 0034,0035,0042,0072 and 0073);
and

notifying means for notifying said destination of said code information issued by said issuing means, (paragraphs 0073,0076,0078).

Regarding claim 2, Mousseau, as applied to claim 1, teaches wherein said electronic mail information that cannot be outputted in said destination is an attached file of an electronic mail, (paragraphs 0035 and 0076).

Regarding claim 3, Mousseau, as applied to claim 2, teaches wherein said attached file is image data, (paragraph 0035).

Regarding claim 4, Mousseau, as applied to claim 2, teaches wherein said attached file is application data, (paragraph 0035).

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Regarding claim 6, Mousseau, as applied to claim 1, teaches wherein said notifying means notifies information to the effect that electronic mail information can be outputted in another terminal by code information issued by said issuing means together with said code information, (paragraphs 0073,0076 and 0078).

Regarding claim 7, Mousseau, as applied to claim 1, teaches wherein said notifying means notifies information such as a sender of said electronic mail information together with information to the effect that said electronic mail information can be outputted in another terminal by code information issued by said issuing means and with said code information, (paragraphs 0073,0076 and 0078).

Regarding claim 8, Mousseau, as applied to claim 1, teaches wherein said destination of said electronic mail information is a portable terminal, (paragraphs 0034 and 0035), and said notifying means notifies said portable terminal of code information, (paragraphs 0076 and 0078).

Regarding claim 9, Mousseau, as applied to claim 8, teaches transmitting means for transmitting said electronic mail information to said portable terminal if it is determined by said first determining means that said electronic mail information can be outputted, (paragraph 0034).

Regarding claim 10, Mousseau, as applied to claim 1, teaches second determining means for determining whether or not said electronic mail information, which is determined by said first determining means to be unable to be outputted, can be outputted in said another terminal, (paragraphs 0034,0035 and 0076),

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wherein said issuing means issues code information for electronic mail information that is determined by said second determined means to be able to be outputted, (paragraphs 0034,0035 and 0076).

Regarding claim 11, Mousseau, as applied to claim 10, teaches registering means for registering said electronic mail information that is determined by said second determining means to be able to be outputted, (paragraphs 0035 and 0073).

Regarding claim 12, Mousseau teaches an output terminal (displayer) for outputting said electronic mail information registered in said registering means if said code information notified by said notifying means is inputted, (paragraphs 0076 and 0078).

Regarding claim 13, Mousseau, as applied to claim 1, teaches wherein said issuing means issues code information if it is determined that said destination of said electronic mail Information is a user of a predetermined service, (abstract; paragraph 0035).

Regarding claim 14, Mousseau, as applied to claim 12, teaches wherein said output terminal includes printing means, (paragraph 0035).

Regarding claim 15, Mousseau teaches an information providing device (abstract; fig. 1) comprising:

receiving means for receiving electronic mail information that is determined to be unable to be outputted in a destination of said electronic mail, (paragraphs 0016,0042 and 0049);

determining means for determining whether or not said electronic mail information received by said receiving means can be outputted in another terminal, (paragraphs 0035 and 0076);

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issuing means for issuing code information for said electronic mail information that is determined by said determining means to be able to be outputted, (paragraphs 0034,0072 and 0073); and

notifying means for notifying said destination of said code information issued by said issuing means, (paragraphs 0073 and 0076).

Regarding claim 16, Mousseau, as applied to claim 15, teaches registering means for registering electronic mail information that is determined by said determining means to be able to be outputted, (paragraphs 0035 and 0073).

Regarding claim 17, Mousseau, as applied to claim 15, teaches wherein said issuing means issues code information if said destination of said electronic mail information is determined to be a user of a predetermined service, (abstract; paragraph 0034).

Regarding claim 18, Mousseau, as applied to claim 15, teaches wherein said electronic mail that cannot be outputted in said destination is an attached file of an electronic mail, (paragraph 0035).

Regarding claim 19, Mousseau teaches wherein said attached file is image data, (paragraph 0035).

Regarding claim 20, Mousseau, as applied to claim 18, teaches wherein said attached file is application data, (paragraph 0035).

Regarding claim 22, Mousseau, as applied to claim 15, teaches wherein said another terminal includes printing means, (paragraph 0035).

Regarding claim 23, Mousseau teaches an information providing device, (abstract; fig. 1), comprising:

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receiving means for receiving electronic mail information, (paragraph 0049);

determining means for determining whether or not said electronic mail information can be outputted in a destination of said electronic mail information, (paragraphs 0016,0034,0035 and 0042);

code information receiving means for receiving code information for outputting said electronic mail information, which is determined by said determining means to be unable to be outputted, in another terminal, (paragraphs 0034,0035,0042,0072 and 0073); and

notifying means for notifying said code information received by said code information receiving means to said destination, (paragraphs 0073,0076 and 0078).

Regarding claim 24, Mousseau, as applied to claim 23, teaches wherein said electronic mail information that cannot be outputted in said destination is an attached file of an electronic mail, (paragraph 0035).

Regarding claim 25, Mousseau, as applied to claim 24, teaches wherein said attached file is image data, (paragraph 0035).

Regarding claim 26, Mousseau, as applied to claim 24, teaches wherein said attached data is application data, (paragraph 0035).

Regarding claim 28, Mousseau, as applied to claim 23, teaches wherein said notifying means notifies information to the effect that said electronic mail information can be outputted in another terminal by code information together with said code information, (paragraphs 0073 and 0076).

Regarding claim 29, Mousseau teaches an information providing method (abstract; fig. 1) comprising:

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a receiving step for receiving electronic mail information, (paragraph 0049);

a first determining step for determining whether or not said electronic mail information can be outputted in a destination of said electronic mail information, (paragraph 0016,0034,0035 and 0042);

an issuing step for issuing code information for outputting said electronic mail information in another terminal if it is determined by said first determining step that said electronic mail information cannot be outputted, (paragraph 0034,0035,0042,0072 and 0073);

and a notifying step for notifying said destination of said code information issued by said issuing step, (paragraph 0073,0076 and 0078).

Regarding claim 30, Mousseau, as applied to claim 29, teaches wherein said electronic mail that cannot be outputted in said destination is an attached file of an electronic mail, (paragraph 0035).

Regarding claim 31, Mousseau, as applied to claim 30, teaches wherein said attached file is image data, (paragraph 0035).

Regarding claim 32, Mousseau, as applied to claim 30, teaches wherein said attached file is application data, (paragraph 0035).

Regarding claim 34, Mousseau, as applied to claim 29, teaches wherein said notifying step notifies information to the effect that said electronic mail information can be outputted in another terminal by code information issued by said issuing means together with said code information, (paragraphs 0073,0076 and 0078).

Regarding claim 35, Mousseau, as applied to claim 29, teaches wherein said notifying step notifies information such as sender of said electronic mail information together with

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information to the effect that said electronic mail information can be outputted in another terminal by code information issued by said issuing step and with said code information, (paragraph 0073).

Regarding claim 36, Mousseau, as applied to claim 29, teaches wherein said notifying step notifies a portable terminal being a destination of said electronic mail information of code information, (paragraph 0073, 0076 and 0078).

Regarding claim 37, Mousseau, as applied to claim 36, teaches a transmitting step for transmitting said electronic mail information to a portable terminal if it is determined by said first determining step that said electronic mail information cannot be outputted, (paragraph 0073).

Regarding claim 38, Mousseau, as applied to claim 29, teaches a second determining step for determining whether or not electronic mail information that is determined by said first determining step to be unable to be outputted can be outputted in said another terminal, wherein said issuing step issues code information for electronic mail information that is determined by said second determining step to be able to be outputted, (paragraph 0073).

Regarding claim 39, Mousseau, as applied to claim 38, teaches a registering step for registering electronic mail information that is determined by said second determining step to be able to be outputted, (paragraph 0035 and 0073).

Regarding claim 40, Mousseau, as applied to claim 29, teaches wherein said issuing step issues code information if it is determined that said destination of said electronic mail is a user of a predetermined service, (abstract; paragraph 0035).

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Regarding claim 41, Mousseau teaches an information providing method (abstract; fig. 1) comprising:

a receiving step for receiving electronic mail information that is determined to be unable to be outputted in a destination of said electronic mail information, (paragraphs 0016,0042,0034 and 0035);

a determining step for determining whether or not said electronic mail information received by said receiving step can be outputted in another terminal, (paragraphs 0016,0042,0034 and 0035);

an issuing step for issuing code information for said electronic mail information that is determined by said determining step to be able to be outputted, (paragraphs 0034,0035,0042,0072 and 0073); and

a notifying step for notifying said destination of said code information issued by said issuing step, (paragraph 0073,0076 and 0078).

Regarding claim 42, Mousseau, as applied to claim 41, teaches a registering step for registering electronic mail information that is determined by said determining step to be able to be outputted, (paragraphs 0035 and 0073).

Regarding claim 43, Mousseau, as applied to claim 41, teaches wherein said issuing step issues code information if it is determined that said destination of said electronic mail information is a user of a predetermined service, (paragraph 0034; abstract).

Regarding claim 44, Mousseau, as applied to claim 41, teaches wherein said electronic mail information that cannot be outputted in said destination is an attached file of an electronic mail, (paragraph 0035).

Regarding claim 45, Mousseau, as applied to claim 44 teaches wherein said attached file is image data, (paragraph 0035).

Regarding claim 46, Mousseau, as applied to claim 44, teaches wherein said attached file is application data, (paragraph 0035).

Regarding claim 47, Mousseau, as applied to claim 41, teaches wherein said electronic mail information that cannot be outputted in said destination is an electronic mail exceeding a maximum number of characters that said destination can receive.

Regarding claim 48, Mousseau, as applied to claim 41, teaches wherein said another terminal includes a printing step, (paragraph 0035).

Regarding claim 49, Mousseau teaches an information providing method (abstract; fig. 1) comprising:

a receiving step for receiving electronic mail information, (paragraph 0049);

a determining step for determining whether or not said electronic mail information can be outputted in a destination of said electronic mail information, (paragraphs 0016,0034,0035 and 0042);

a code information receiving step for receiving code information for outputting in another terminal said electronic mail information that is determined by said determining step to be unable to be outputted, (paragraphs 0034,0035,0042,0072 and 0073); and

a notifying step for notifying said destination of said code information received by said code information receiving step, (paragraphs 0073,0076 and 0078).

Regarding claim 50, Mousseau, as applied to claim 49, teaches wherein said electronic mail information that cannot be outputted in said destination is an attached file of an electronic mail, (paragraph 0035).

Regarding claim 51, Mousseau, as applied to claim 50, teaches wherein said attached file is image data, (paragraph 0035).

Regarding claim 52, Mousseau, as applied to claim 50, teaches wherein said attached file is application data, (paragraph 0035).

Regarding claim 54, Mousseau, as applied to claim 49, teaches wherein said notifying step notifies information to the effect that electronic mail information can be outputted in another terminal by code information together with said code information, (paragraphs 0073,0076 and 0078).

Regarding claims 55-56, Mousseau teaches a program executable by a computer and a computer readable storage medium storing a program (abstract) comprising:

a program code of a receiving step for receiving electronic mail information, (paragraph 0049);

a program code of a first determining step for determining whether or not said electronic mail information can be outputted in a destination of said electronic mail information, (redirector program; paragraphs 0016,0034,0035 and 0042);

a program code of an issuing step for issuing code information for outputting said electronic mail information in another terminal if it is determined by said first determining step that said electronic mail information cannot be outputted, (paragraphs 0034,0035,0042,0072 and 0073); and

a program code of a notifying step for notifying said destination of said code information issued by said issuing step, (paragraphs 0073,0076 and 0078).

Regarding claims 57-58, Mousseau teaches a program executable by a computer and a computer readable storage medium storing a program (abstract) comprising:

a program code of a receiving step for receiving electronic mail information that is determined to be unable to be outputted in a destination of said electronic mail information, (paragraph 0049);

a program code of a determining step for determining whether or not said electronic mail information received by said receiving step can be outputted in another terminal, (paragraphs 0016,0034,0035 and 0042);

a program code of an issuing step for issuing code information for said electronic mail information that is determined by said determining step to be able to be outputted, (paragraphs 0034,0035,0042,0072 and 0073); and;

and a program code of a notifying step for notifying said destination of said code information issued by said issuing step, (paragraphs 0073,0076 and 0078).

Regarding claims 59-60, Mousseau teaches a program executable by a computer and a computer readable storage medium storing a program (abstract) comprising:

a program code of a receiving step for receiving electronic mail information, (paragraph 0049);

a program code of a determining step for determining whether or not said electronic mail information can be outputted in a destination of said electronic mail information, (paragraphs 0016,0034,0035 and 0042);

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a program code of a code information receiving step for receiving code information for outputting in another terminal said electronic mail information that is determined by said determining step to be unable to be outputted (paragraphs 0034,0035,0042,0072 and 0073); and a program code of a notifying step for notifying said destination of said code information received by said code information receiving step, (paragraphs 0073,0076 and 0078).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 5,21,27,33 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mousseau in view of Watanabe et al. US Patent Pub. 2001/0034226.

Regarding claims 5,21,27,33 and 53, Mousseau teaches of handling electronic mail that cannot be outputted in said destination, as shown above. Mousseau does not specifically teaches wherein said electronic mail information that cannot be outputted in said destination is an electronic mail exceeding a maximum number of characters that said destination can receive.

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In the same field of endeavor, Watanabe teaches of determining that the e-mail cannot be outputted in a destination if the maximum number of character is exceeded, (paragraphs 0050 and 0052)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Mousseau by determining that the e-mail cannot be outputted if the maximum number of characters is exceed so that the user can be notified that there destination device cannot view the entire message.

Conclusion

13. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9306, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

220 20th Street S.
Crystal Plaza two, Lobby, Room 1B03
Arlington, VA 22202

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 703-308-6262. The examiner can normally be reached on M-F (6:30AM - 5:00PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER



Ovidio Escalante
Examiner
Group 2645
December 3, 2004

O.E./oe